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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,546	05/22/2000	Nathalie Jager Lezer	05725.0588-00000	1552

22852 7590 03/08/2002

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EXAMINER

TRAN, SUSAN T

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 03/08/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/576,546

Applicant(s)

Lezer

Examiner

Susan Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 4, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above, claim(s) 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 14-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Receipt is acknowledged of applicant's Information Disclosure Statement filed 05/22/00, Election filed 12/21/00, Request for Extension of Time filed 06/25/01 and 02/04/02, Amendment A filed 06/25/01, Amendment B filed 11/05/01, Request for Continued Examination filed 02/04/02, and Request for Reconsideration filed 02/04/02.

This application is a CPA of the above Serial Number filed 05/22/00.

### ***Claim Rejections - 35 U.S.C. § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-7, 15-18, 20, 23, 24, 26-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Arraudeau et al. US 4,659,562.

Arraudeau teaches an anhydrous cosmetic composition comprising fiber having length much greater than diameter (column 1, lines 11-62), propylene glycol dicaprylate, glycerol, and oils (column 2, lines 40 through column 3, lines 1-9; and examples 1, 2, 7, 8, 12, 13).

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*Claim Rejections - 35 U.S.C. § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 15-18, 20, 23, 24, 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arraudeau et al.

Arraudeau is relied upon for the reason stated above. In the case that applicant can overcome the 102(b) rejection, the examiner relies upon the following 103(a) rejection.

Regarding to claims 2 and 3, Arraudeau is silent as to the teaching of IOB value. However, Arraudeau discloses the use of the same polyol to obtain the same result, desire by the applicant, e.g., an anhydrous make-up formulation. Therefore, it would have been obvious for one of ordinary skill in the art to, by routine experimentation determine a suitable IOB value and select a desirable polyol. The expected result would be an anhydrous make-up formulation that last long, and do not smear.

3. Claims 1-7, 15-18, 20, 23, 24, 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arraudeau et al., in view of Yoshioka et al. JP 404159218A.

Arraudeau is relied upon for the reasons stated above. The reference is silent as to the teaching of IOB value.

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Yoshioka teaches a gelatin capsule useful in the field of cosmetics comprising humectant having IOB value of 3.5, e.g., propylene glycol, polyethylene glycol, dipropylene glycol, or 1,3-butylene glycol (see abstract). Hence, it would have been prima facie obvious for one of ordinary skill in the art to modify Arraudeau's cosmetic composition using propylene glycol having IOB value of 3.5 in view of the teaching of Yoshioka. The reason for this modification is to obtain an anhydrous cosmetic composition capable of maintaining uniformity/stability for periods of time.

4. Claims 1-7, 15-18, 20, 23, 24, 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arraudeau et al., in view of Japanese abstract from Shiseido JP 05320038A (JP 038).

Arraudeau is relied upon for the reasons stated above. The reference is silent as to the teaching of IOB value.

JP 038 teaches a cosmetic composition containing up to 10% water, and at least 3% of one or mixture of polyethylene glycol, and polyoxy compounds having IOB value of up to 3.5 (see abstract). Thus, it would have been prima facie obvious for one of ordinary skill in the art to modify Arraudeau's cosmetic composition using propylene glycol having IOB value of 3.5 in view of the teaching of JP 038. The reason for this modification is to obtain a very satisfactory anhydrous make-up composition useful in cosmetic art.

5. Claims 1 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arraudeau et al., and Franzke et al. US 5,965,146.

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Arraudeau is relied upon for the reasons stated above. Regarding to claim 14, Arraudeau does not teach the claimed fiber.

Franzke teaches a cosmetic composition comprising polyamide fiber having diameter of 8 to 70  $\mu\text{m}$ , and length of between 20 to 2000  $\mu\text{m}$  (columns 1-2). Hence it would have been prima facie obvious for one of ordinary skill in the art to modify Arraudeau's fiber with polyamide fiber in view of the teaching of Franzke, because the references teach the advantageous results in the use of fibers. The expected result would be an anhydrous make-up formulation containing fiber useful for cosmetic fields.

6. Claims 14-22, and 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arraudeau et al., in view of Bara et al. US 6,177,091.

Arraudeau is relied upon for the reasons stated above. Arraudeau does not teach parleam oil.

Bara teaches an anhydrous cosmetic composition comprising fiber, and oils, e.g. parleam oil (columns 2-5). Thus, it would have been prima facie obvious for one of ordinary skill in the art to modify Arraudeau's oil using parleam oil in view of the teaching of Bara. The reason for this modification is to obtain an anhydrous cosmetic composition that prevents unaesthetic folds, migration, and thus provides long lasting property on skin or lips. The expected result would be an anhydrous make-up formulation containing fiber useful for cosmetic fields.

With regarding to the length and diameter of the fiber, it is the position of the examiner that it would have been obvious for one of the ordinary skill in this art to, by routine

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experimentation determine a suitable length and diameter of the fiber to obtain a desired anhydrous cosmetic formulation that will provide a long lasting appearance, and thus will not require repeated applications.

*Response to Arguments*

7. Applicant's arguments filed 02/04/02 have been fully considered but they are not persuasive.

Applicant argues that Arraudeau discloses an almost infinite number of oils list. Contrary to the applicant's argument, when one of ordinary skill in this art considers the disclosure and the teachings of Arraudeau as exemplified at column 2, lines 52 through column 3, lines 6-9, the oil would be envisioned, and therefore, anticipated. It is the position of the examiner that the almost infinite number of oil as argued by the applicant can be envisioned by the skilled artisan because Arraudeau teaches oils of animal, plant, or silicone oils as claimed by the applicant in claims 23-24.

Applicant argues that Franzke does not teach an anhydrous cosmetic composition. The term "anhydrous composition" is defined in applicant's specification at page 5 as being "a composition comprising a homogeneous continuous fatty phase in which may be dispersed ingredients that are insoluble in the fatty phase, in the absence of surfactant or emulsifier, such as dyestuffs and cosmetic or dermatological active agents, including water. In particular, the water will be present in a content of not more than 6% relative to the total weight of the composition".

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Applicant's specification at page 15, further discloses the composition of the invention can also comprise any ingredients, such as dyestuffs, e.g., pigments; cosmetic or dermatological active agents, such as emollients, moisturizers, e.g., water. Franzke at column 3, lines 52-58 discloses water, wetting agents, or emulsifier agents in an amount of from 0.1 to 30% by weight, which clearly falls within the water content defines in the applicant's specification.

Applicant argues that Franzke does not teaches a cosmetic composition comprises a homogenous continuous fatty phase, but a composition comprises ethanol. Contrary to the applicant's argument, Franzke teaches a cosmetic composition comprising polyamide fiber having diameter of 8 to 70  $\mu\text{m}$ , length between 20 to 2000  $\mu\text{m}$  (column 1, lines 56 through column 2, lines 1-67; and example 18), glycols, silicone oil, and polymers (column 3, lines 1-36). Hence, Franzke does teach an anhydrous cosmetic composition comprising fiber and polyol. Applicant's generic claims do not exclude the present of alcohols.

Applicant argues that Franzke's examples discloses aqueous or ethanol base composition but not a homogenous continuous fatty phase. Franzke is relied upon for the teaching within the four walls patent. Franzke cannot be limited to his best mode as described in the examples.

Applicant argues that Arnaud abstract was published on June 2, 2000, which is after the claimed priority date. The examiner has withdrawn the 103(a) rejection over Arnaud.



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*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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